

**IN THE UNITED STATES DISTRICT COURT  
FOR THE DISTRICT OF DELAWARE**

RONALD A. KATZ TECHNOLOGY	)
LICENSING, L.P.,	)
	)
Plaintiff,	)
	) C.A. No. 06-547 (GMS)
AMERICAN INTERNATIONAL GROUP,	)
INC., <i>et al.</i> ,	)
	)
Defendants	)

**DHL'S JOINDER IN DEFENDANT AQUILA, INC.'S MOTION TO STAY  
ACTION PENDING THE U.S. PATENT AND  
TRADEMARK OFFICE'S REEXAMINATION OF PLAINTIFF'S PATENTS**

Defendants DHL Holdings (USA), Inc., DHL Express (USA) Inc., and Sky Courier, Inc. (collectively, "DHL") hereby join the Motion To Stay Action Pending the U.S. Patent and Trademark Office's Reexamination of Plaintiff's Patent filed by defendant Aquila Inc. ("Aquila") on December 19, 2006 (the "Aquila Motion").

As stated in the Aquila Motion, on September 1, 2006, Plaintiff Ronald A. Katz Technology Licensing, L.P. ("Plaintiff") filed five actions in this District<sup>1</sup> accusing a total of ninety-five defendants of infringing one or more of twenty-six U.S. patents.<sup>2</sup> Plaintiff

---

<sup>1</sup>Ronald A. Katz Technology Licensing, L.P. v. Reliant Energy, Inc., *et al.* (C.A. No. 1:06-cv-00543), Ronald A. Katz Technology Licensing, L.P. v. TD Banknorth, Inc., *et al.* (C.A. No. 1:06-cv-00544), Ronald A. Katz Technology Licensing, L.P. v. Ahold USA, Inc., *et al.* (C.A. No. 1:06-cv-0545), Ronald A. Katz Technology Licensing, L.P. v. Time Warner Cable, Inc., *et al.* (C.A. No. 1:06-cv-0546), and Ronald A. Katz Technology Licensing, L.P. v. American International Group, Inc., *et al.* (C.A. No. 1:06cv-00547).

<sup>2</sup> The twenty-six asserted patents are U.S. Patent No. 4,792,968 ("the '968 patent"); 4,930,150 ("the '150 patent"); 4,939,773 ("the '773 patent"); 4,987,590 ("the '590 patent"); 5,128,984 ("the '984 patent"); 5,251,252 ("the '252 patent"); 5,297,197 ("the '197 patent"); 5,351,285 ("the '285 patent"); 5,442,688 ("the '688 patent"); 5,684,863 ("the '863 patent"); 5,787,156 ("the '156 patent"); 5,815,551 ("the '551 patent"); 5,828,734 ("the '734 patent"); 5,835,576 ("the '576 patent"); 5,898,762 ("the '762 patent"); 5,917,893 ("the '893 patent"); 5,974,120 ("the '120 patent"); 6,035,021 ("the '021 patent"); 6,148,065 ("the '065 patent"); 6,335,965 ("the '965 patent"); 6,349,134

has asserted seventeen of the twenty-six patents against DHL in this action.<sup>3</sup> Currently, ten of Plaintiff's patents are involved in reexamination proceedings before the U.S. Patent and Trademark Office.<sup>4</sup> Of these ten patents, five of the patents that are asserted against DHL are in reexamination proceedings before the U.S. Patent and Trademark Office.<sup>5</sup>

For the reasons cited in the Aquila Motion, DHL respectfully requests that the Court stay this action in its entirety pending the completion of the reexamination proceedings by the U.S. Patent and Trademark Office involving Plaintiff's U.S. patents that have been asserted in this action as well as other related but unasserted patents.

---

(“the ‘134 patent”); 6,424,703 (“the ‘703 patent”); 6,434,223 (“the ‘223 patent”); 6,449,346 (“the ‘346 patent”); 6,512,415 (“the ‘415 patent”); and 6,678,360 (“the ‘360 patent”) (collectively, “the asserted patents”).

<sup>3</sup> The seventeen patents asserted against DHL in this case include the ‘065 patent, the ‘120 patent, the ‘134 patent, the ‘150 patent, the ‘223 patent, the ‘252 patent, the ‘285 patent, the ‘360 patent, the ‘415 patent, the ‘551 patent, the ‘703 patent, the ‘734 patent, the ‘863 patent, the ‘893 patent, the ‘965 patent, the ‘968 patent, and the ‘984 patent.

<sup>4</sup> The ten patents currently involved in reexamination proceedings include U.S. Patent Nos. 5,255,309, 5,259,023, 5,351,285, 5,561,707, 5,684,863, 5,787,156, 5,815,551, 5,828,734, 6,292,547, and 6,434,223. In addition, requests for reexamination of U.S. Patent Nos. 5,128,984 and 5,974,120 have been submitted to the U.S. Patent and Trademark Office, but the PTO has not yet acted on the requests.

<sup>5</sup> The five patents currently asserted against DHL, that are simultaneously involved in reexamination proceedings, include the ‘223 patent, the ‘285 patent, the ‘551 patent, the ‘734 patent, and the ‘863 patent.

Respectfully submitted,

POTTER ANDERSON & CORROON LLP

OF COUNSEL:

Daniel J. Thomasch  
Alex V. Chachkes  
ORRICK, HERRINGTON & SUTCLIFFE LLP  
666 Fifth Avenue  
New York, New York 10103  
Tel: (212) 506-5000  
Fax: (212) 506-5151

By: /s/ David E. Moore  
Richard L. Horwitz (#2246)  
David E. Moore (#3983)  
Hercules Plaza, 6<sup>th</sup> Floor  
1313 N. Market Street  
Wilmington, Delaware 19899-0951  
Tel: (302) 984-6000  
[rhorwitz@potteranderson.com](mailto:rhorwitz@potteranderson.com)  
[dmoore@potteranderson.com](mailto:dmoore@potteranderson.com)

Dated: December 21, 2006

*Attorneys for Defendants*  
*DHL Holdings (USA), Inc.,*  
*DHL Express (USA), Inc. and*  
*Sky Courier, Inc.*

768019 / 30750

**IN THE UNITED STATES DISTRICT COURT  
FOR THE DISTRICT OF DELAWARE**

**CERTIFICATE OF SERVICE**

I, David E. Moore, hereby certify that on December 21, 2006, the attached document was hand delivered and electronically mailed to the following persons and was electronically filed with the Clerk of the Court using CM/ECF which will send notification to the registered attorney(s) of record that the document has been filed and is available for viewing and downloading:

Andre G. Bouchard  
John M. Seaman  
Bouchard Margules & Freidlander, P.A.  
222 Delaware Avenue, Suite 1400  
Wilmington, DE 109801  
[abouchard@bmf-law.com](mailto:abouchard@bmf-law.com)  
[jseaman@bmf-law.com](mailto:jseaman@bmf-law.com)

I hereby certify that on December 21, 2006, I have sent by Electronically Mailed the foregoing document to the following:

Steven J. Balick, Esq.  
John G. Day, Esq.  
Lauren E. Maguire, Esq.  
Ashby & Geddes  
222 Delaware Avenue, 17<sup>th</sup> Floor  
Wilmington, DE 19801  
[sbalick@ashby-geddes.com](mailto:sbalick@ashby-geddes.com)  
[jday@ashby-geddes.com](mailto:jday@ashby-geddes.com)  
[lmauguire@ashby-geddes.com](mailto:lmauguire@ashby-geddes.com)

Collins J. Seitz, Jr., Esq.  
Connolly Bove Lodge & Hutz, LLP  
The Nemours Building  
1007 N. Orange Street  
Wilmington, DE 19899  
[cseitz@cblh.com](mailto:cseitz@cblh.com)

Danielle Gibbs, Esq.  
Karen E. Keller, Esq.  
Young, Conaway, Stargatt & Taylor, LLP  
The Brandywine Building  
1000 West Street, 17<sup>th</sup> Floor  
Wilmington, DE 19801  
[kkeller@ycst.com](mailto:kkeller@ycst.com)  
[dgibbs@ycst.com](mailto:dgibbs@ycst.com)

Philip A. Rovner  
Potter Anderson & Corroon LLP  
Hercules Plaza  
1313 N. Market Street  
P.O. Box 951  
Wilmington, DE 19899-0951  
[rovner@potteranderson.com](mailto:rovner@potteranderson.com)

Sean J. Bellew, Esq.  
David A. Felice, Esq.  
Cozen O'Connor  
Chase Manhattan Centre  
1201 N. Market Street  
Suite 1400  
Wilmington, DE 19801  
[sbellew@cozen.com](mailto:sbellew@cozen.com)  
[deflice@cozen.com](mailto:deflice@cozen.com)

*/s/ David E. Moore*

---

Richard L. Horwitz (#2246)  
David E. Moore (#3983)  
Potter Anderson & Corroon LLP  
Hercules Plaza  
Wilmington, DE 19899  
(302) 984-6000  
[rhorwitz@potteranderson.com](mailto:rhorwitz@potteranderson.com)  
[dmoore@potteranderson.com](mailto:dmoore@potteranderson.com)

752371 / 30750